

2013

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

RECEIVED

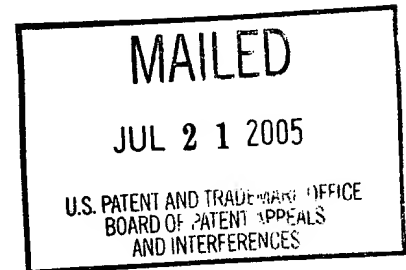
AUG 8 - 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2000

Ex parte BARTHOLOMEW J. FRAZZITTA,
RANDOLPH C. BENORE,
DANIEL S. MCINTYRE,
MARK A. DePIETRO,
and JEFFREY M. KALMAN

Appeal No. 2004-1711
Application 08/889,033¹

ON BRIEF



Before BARRETT, BARRY, and BLANKENSHIP, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the non-final rejection of claims 1-47.

We reverse and remand.

¹ Application for patent filed July 7, 1997, entitled "Transaction System," which is based on and claims priority under 35 U.S.C. § 119(e)(1) from U.S. Provisional Application 60/045,794, filed May 7, 1997.

BACKGROUND

The invention relates to a system for carrying out transactions, which includes a service provider (SP) station operated by a service provider such as a cashier, clerk, or teller, and a customer station operated by a customer requesting a transaction. An example is a bank customer conducting a transaction with a bank teller. Audio and video communications may be conducted between the SP station and the customer station using cameras, displays, microphones, and speakers. Items may be exchanged between customers and the service provider utilizing carriers transmitted through a pneumatic tube system. Various claims are directed to the mounting and cover structure.

Claim 1 is reproduced below.

1. A transaction system comprising:

a service provider (SP) station, wherein the SP station is enabled to be operated by a service provider providing a transaction, wherein the SP station includes therein an SP carrier delivery and receiving device and at least one component of:

- an SP visual display,
- an SP camera,
- an SP audio transmitting device,
- an SP audio receiving device,

at least one customer station, wherein the customer station is enabled to be operated by a customer requesting a transaction, wherein the customer station includes therein a customer carrier delivery and receiving device and at least one component of:

a customer visual display,
a customer camera,
a customer audio transmitting device,
a customer audio receiving device,

wherein the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and receiving device, and wherein a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device,

a building, wherein the SP station and the customer station are positioned inside of the building.

THE REFERENCES

The examiner relies on the following references:

McClure et al. (McClure)	3,294,342	December 27, 1966
Casale et al. (Casale)	5,287,948	February 22, 1994
Kaehler	5,798,931	August 25, 1998 (filed June 6, 1996)
Bustos	5,816,443	October 6, 1998 (filed December 12, 1995)

THE REJECTIONS

Claims 1-4, 12, 13, 18, 19, 24-27, 37-42², and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Casale and Bustos.

Claims 5-11, 14-16, 20-23, 28-36, and 43-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Casale, Bustos, and McClure.

² Note that claim 37 depends on claim 28, which is rejected over Casale, Bustos, and McClure. Thus, claim 37 should be grouped with claim 28.

Appeal No. 2004-1711
Application 08/889,033

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Casale, Bustos, McClure, and Kaehler.

We refer to the non-final rejection (Paper No. 17) (pages referred to as "R__") and the examiner's answer (Paper No. 22³) (pages referred to as "EA__") for a statement of the examiner's rejection, and to the supplemental appeal brief (Paper No. 21) (pages referred to as "Br__") and reply brief (Paper No. 23) (pages referred to as "RBr__") for a statement of appellants' arguments thereagainst.

OPINION

Casale and Bustos

Claim 1

The examiner finds that Casale teaches, expressly or by principles of inherency, the claimed invention except for the customer station being inside the building. The examiner finds that Bustos teaches customer stations inside and outside a building and concludes that it would have been obvious to construct the customer stations inside the building (R6-7; EA5).

Appellants argue that Casale does not disclose the following claimed features of claim 1 (Br15):

- (1) "the SP station and the customer station are positioned inside of the building";

³ The examiner's answer mailed July 16, 2003, erroneously has Paper No. 14 on the cover page.

- (2) an "SP carrier delivery and receiving device" and a "customer carrier delivery and receiving device";
- (3) "the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and receiving device"; and
- (4) "a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device."

Appellants note (Br15-16) that the examiner is vague about what constitutes the "customer station" in Casale. It is argued that in Casale customers first place their orders at a menu location 52 and then drive to a pick-up window 22 to pay for and receive the orders, where the transaction occurs by hand at the pick-up window 22 (Br16). It is argued that there is no delivery device at the menu location 52 where the customer places the order and, since the food is handed to the customer, there is no need for a delivery device at the window (Br16). Nor, it is argued, is there a camera, display, audio receiving/transmitting device at the pick-up window 22 (Br16). Appellants further argue that Casale does not disclose a "service provider (SP) station" and the second level housing 14 cannot be the SP station, as asserted by the examiner, because there is no suggestion that it has one of the four components and it also lacks the SP carrier delivery and receiving system (Br17-18).

The examiner finds that the base housing 12 of Casale corresponds to the customer station (EA3).

We agree with appellants that Casale does not disclose a customer station and an SP station, each having at least one component and a carrier delivery and receiving system, as recited in claim 1. The remotely located menu and order display unit in Fig. 13 is operated by a customer requesting a transaction and has all four of the recited components; this cannot be the claimed customer station because it does not have a "customer carrier delivery and receiving device." As noted by appellants, the customer must go to the window to pick up the meal and there is no reason for any of the components at the pick-up window where there is a live person; thus, the pick-up window cannot be the claimed customer station because it has no components. Furthermore, the window location does not have a "customer carrier delivery and receiving device." The conveyor 90 in Figs. 8-11, 14, and 15 delivers food from the top level to a service person at the bottom level who hands it to the customer through a window, it does not deliver food directly to the customer and the customer does not have access to the conveyor. Thus, even assuming that the conveyor 90 is a "carrier delivery and receiving device," it is not at a customer station even if the remote unit and the pick-up window are somehow considered to be part of an overall customer station (which is not a position set forth by the examiner). The rejection does not rely on Bustos for the customer station, but appellants argue anyway that

Appeal No. 2004-1711
Application 08/889,033

Bustos does not disclose or suggest the recited customer station (Br24-25). The customers in Bustos order items using an electronic entry device 22 associated with a credit card reader and does not require any of the components. We agree with appellants' arguments about Bustos.

Casale also does not teach the claimed SP station having at least one component and a carrier delivery and receiving system. Casale discloses that the customer communicates with a cashier or person taking the order within the base level housing 12 (col. 6, lines 29-35), thus, the visual display, camera, microphone, and speaker for the cashier service provider are in the lower housing near the lower end of the conveyor 90. The lower end of the conveyor cannot be both an SP carrier delivery and receiving system and a customer carrier delivery and receiving system. The examiner does not rely on Bustos, but appellants argue that Bustos does not disclose or suggest the recited SP station (Br26-27). We agree with appellants' arguments about Bustos.

Appellants further argue that Casale does not teach a "customer station ... positioned inside of the building." The examiner relies on Fig. 5D of Bustos as teaching that a customer station can be inside a building (R6). Appellants argue that it would not have been obvious to modify Casale to place customer stations inside the building in view of Bustos because:

(1) Casale desires customers to remain outside of the building

(Br20-21); (2) Casale's building is not structurally capable of supporting an interior customer station (Br21-22); (3) Casale has no need of the recited customer station (Br22-23); (4) an interior customer station would destroy the disclosed benefits of Casale (Br23-24); and (5) it would not have been obvious to insert the alleged customer station of Bustos into Casale (Br27).

In our opinion, if Casale taught an outside customer station within the claims, it would have been obvious to anyone of ordinary skill in the art to locate a customer station inside a building for many reasons, among them to let the customers get out of bad weather, because it would be desirable to locate customer stations where the customer are, which is often indoors at locations such a shopping malls, and because there are numerous examples of customer service locations which are located both inside and outside, such as automatic teller machines (ATMs) and food service counters. It is not necessary for the references to be physically combinable. See In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983). Thus, we do not base our decision on the limitation of "positioned inside of the building."

As to the limitations of an "SP carrier delivery and receiving device" and a "customer carrier delivery and receiving device," "the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and

Appeal No. 2004-1711
Application 08/889,033

receiving device," and "a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device," appellants argue that both Casale and Bustos are one-way systems that do not disclose or suggest moving a transaction item from a customer station to an SP station and vice versa and are incapable of such function (Br18-20; Br24-25).

We do not find where the examiner addresses these arguments. However, we have considered the references and agree with appellants. The conveyor 90 in Casale is used to deliver items from an upstairs source to a downstairs service person who then delivers it through a window to a customer. Even assuming, arguendo, that the source is the SP station and the end of the conveyor is a customer station, the SP station only delivers and the customer station only receives--they do not each deliver and receive, as claimed. In fact, the conveyor embodiment of Fig. 14 is not capable of delivering to the upstairs station. The conveyor embodiment of Figs. 9-11 might be able to send from the first level to the second level, but is clearly not intended to do so because the food carrier slides down an off-loading ramp 97 and it would be necessary for a person to climb up to put items on the tray 108. Bustos also is a one-way system for delivering items purchased on a credit card or room charge and the like and does not cure the deficiencies of Casale. There is no disclosure

Appeal No. 2004-1711
Application 08/889,033

that guests in Fig. 5D, or in any of the other embodiments, send anything back using the pneumatic tube.

The rejection of claim 1 is reversed because the combination of Casale and Bustos does not teach or suggest: (1) an "SP carrier delivery and receiving device" and a "customer carrier delivery and receiving device"; (3) "the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and receiving device"; and (4) "a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device."

Claims 38, 2-4, 12, 13, 18, 19, 24-27, and 38-40

The rejection is the same as for claim 1. It is noted that claim 1 recites an "SP carrier delivery and receiving device" and a "customer carrier delivery and receiving device," whereas claim 38 recites an "SP pneumatic tube carrier delivery and receiving device" (emphasis added) and a "customer pneumatic tube carrier delivery and receiving device" (emphasis added). Claim 38 also differs from claim 1 in requiring all four components of a display, a CCTV camera, an audio transmitting device, and an audio receiving device, whereas claim 1 only requires one of these components. Claim 38 also recites a building with an interior wall and at least one component of the four components and customer carrier device to be in an interior

Appeal No. 2004-1711
Application 08/889,033

area in supporting connection with the interior wall, whereas claim 1 requires the customer station to be positioned inside the building with no limitations on how components are supported.

The rejection does not expressly address the "pneumatic tube" difference. The examiner finds that the "carrier" corresponds to the conveyor trays 94 of Fig. 14 (EA5). However, as appellants point out, the alleged carrier 94 is not associated with a "pneumatic tube" system, but is actually part of a roller and belt arrangement (Br32). That is, the embodiment of Fig. 14 is motor driven (col. 7, lines 52-55), not pneumatic. The embodiment of Figs. 9-11 uses a pneumatic column or track 102 (col. 7, lines 9-14), which perhaps could be considered a pneumatic tube even though it does not correspond to a tube that sends a carrier inside it. Bustos teaches a pneumatic tube delivery system, a one-way system, but the examiner's rejection does not rely on Bustos for this feature.

Appellants arguments parallel those for claim 1 and we reverse the rejection of claim 38 for essentially the same reason as stated in connection with claim 1, i.e., because the combination of Casale and Bustos does not teach or suggest: (1) an "SP pneumatic tube carrier delivery and receiving device" and a "customer pneumatic tube carrier delivery and receiving device"; (2) the customer pneumatic tube carrier delivery and receiving device "in operative connection with the SP pneumatic

Appeal No. 2004-1711
Application 08/889,033

tube carrier and receiving device"; and (3) "wherein a carrier is enabled to be selectively moved between the customer station and the SP station." The rejection of dependent claims 2-4, 12, 13, 18, 19, 24-27, and 38-40 must also be reversed.

Claims 41 and 42

Claim 41 recites a customer station including at least one component, with the component in supporting connection with an interior wall of a building, and "wherein the customer station comprises a frame, and wherein the wall comprises an opening, and wherein the frame is in supporting connection with the wall and extends in the opening, and wherein the at least one component is in supporting connection with the frame." It is noted that the "customer carrier delivery and receiving device" is claimed as one of the components and is not required in addition to one of the four components of visual display, camera, audio transmitting device, and audio receiving device as in claim 1. We interpret a "visual display" to be broad enough to be any kind of visual display, such as the visual display of an ATM.

Appellants argue that the rejection is silent as to what element constitutes the alleged frame and, thus, appellants have been given the undue burden of speculating as to what allegedly constitutes the recited "frame" (Br38). It is true that the rejection appealed from does not mention frames. Appellants note that the examiner alleged in a previous Office action that

Appeal No. 2004-1711
Application 08/889,033

Casale's drive-in window inherently had a "frame" (Br38). Appellants argue that even if the drive-in window in Casale inherently had a frame, there is no indication that it is in supporting connection with an interior wall in an interior area of the building (Br38-39). It is argued that there is no indication that a recited customer station "component is in supporting connection with the frame" because Casale's speaker/microphone, display, and camera are located at the inner housing 52 which is separate and distinct from the alleged frame associated with the drive-in window (Br39). It is further argued that modification of Casale so that a station component is positioned in supporting connection with a window frame would prevent use of the window, destroying the operability of the Casale system (Br39-40). Appellants further argue that Bustos does not disclose or suggest a frame as recited (Br40-41).

The statement of the rejection in the examiner's answer states that "the customer terminal comprises a frame (the drive in window inherently has a frame (a door frame, a window frame or a cashier's access frame) and an opening for customer pick up food or product)" (EA4), which confirms appellants' speculation that the examiner is relying on the window frame. The rejection does not rely on Bustos. The response to the argument section of the answer (EA17) does not respond to appellants' arguments.

Appeal No. 2004-1711
Application 08/889,033

While we agree with the examiner that the windows in Casale inherently have a frame, Casale does not disclose that "at least one component is in supporting connection with the frame." The display, camera, speaker, and microphone components in Casale are disclosed to be located at the inner housing 52 in Fig. 13, which is not at the window. The inner housing 52 is not a wall of a building and, therefore, even if the housing has a frame it is not "in supporting connection with" a wall as claimed. There is no teaching of any component at the window. The conveyor 90 is inside the building and is not at customer station and is not in supporting connection with a frame of the window. The rejection does not rely on Bustos. The combination of Casale and Bustos does not teach a customer station including at least one component "wherein the customer station comprises a frame, and wherein the wall comprises an opening, and wherein the frame is in supporting connection with the wall and extends in the opening, and wherein the at least one component is in supporting connection with the frame." The examiner has failed to establish a prima facie case of obviousness. Thus, the rejection of claims 41 and 42 is reversed.

Claim 47

Claim 47 is directed to a transaction system having an SP station including an SP communication device and a customer station including a customer communication device "in operative

Appeal No. 2004-1711
Application 08/889,033

communication with the SP communication device," both the SP station and customer station positioned inside a building, and including:

a delivery device, wherein the delivery device includes an inner volume therein, wherein the delivery device is adapted to hold a transaction item in the inner volume during a delivery, wherein a transaction item is enabled to be deposited into the inner volume at either of the SP or customer stations, wherein a transaction item is enabled to be received from the inner volume at either of the SP or customer stations, and wherein the delivery device is movable to deliver a deposited transaction item from either of the SP or customer stations to the other respective SP or customer station

Appellants argue that Casale does not disclose the delivery device because there is no teaching of a delivery device capable of delivering a transaction item from the alleged customer station on the side at the lower ground level of the building to the alleged SP station on the upper floor of the building, or that the alleged SP station is capable of receiving a transaction item from the alleged customer station (Br43). It is argued that the customer is not inside the building and is not capable of using the alleged carrier (tray 94). It is argued that the alleged carrier (tray 94) points downward on the upward trip which makes it impossible to hold a food product for movement to the second floor and, further, there is no reason to move food items to the second floor (Br43-44). Appellants argue that Casale does not have the recited SP station and customer station in the same building (Br42; Br44-45). It is further argued that

Appeal No. 2004-1711
Application 08/889,033

Bustos does not overcome the deficiencies in Casale and that combining the teaching of Bustos into Casale would not have produced the claimed invention (Br45-47).

The response to the argument section of the answer (EA17) does not respond to appellants' arguments about claim 47.

We agree with appellants that neither Casale nor Bustos teaches the claimed delivery device. The examiner relies on tray 94 in Fig. 14 as the carrier (EA5). The conveyor embodiment 90 of Fig. 14 is not capable of moving items from the lower floor to the upper floor because the trays hang down on the upward trip. Even if the conveyor was capable of two way delivery of items, Casale does not teach that the delivery device connects an SP station with a customer station. The SP station and customer station must each have a communication device. The customer communication devices are located at the inner housing 52, not at the lower end of the conveyor. Furthermore, since the customer picks up the order at the window, the customer station cannot be located at the conveyor. The SP communication devices in Casale are located at the cashier or person taking the order on the first floor (col. 6, lines 29-35), and so the SP station cannot be located at the upper end of the conveyor. It is not necessary to address appellants' other arguments. The examiner has failed to establish a prima facie case of obviousness. The rejection of claim 47 is reversed.

Appeal No. 2004-1711
Application 08/889,033

Casale, Bustos, and McClure

Dependent claims 5-11, 14-16, and 20-23

The examiner adds McClure to the combination of Casale and Bustos for the rejection of claims 5-11, 14-16 and 20-23, which depend on claim 38, for the teaching of a cover.

While McClure teaches the limitations of independent claim 38, except for at least one component in supporting connection with an interior wall, which could be easily dealt with, the rejection does not apply McClure for this purpose. Since appellants have not been given notice that McClure could be applied to claim 38, reliance on McClure for the limitations of claim 38 would raise a new ground of rejection. See In re Kronig, 539 F.2d 1300, 1302, 190 USPQ 425, 426 (CCPA 1976) (The "ultimate criterion" of whether a rejection is new is "whether appellants have had a fair opportunity to react to the thrust of the rejection."). We decline to enter a new ground of rejection because it would mean that we would have to examine the claims in the first instance. Even if McClure did teach the limitations of the claims to which it is applied, it has not been applied by the examiner to cure the deficiencies of Casale and Bustos as to claim 38. Accordingly, the rejections of claims 5-11, 14-16, and 20-23 are reversed.

Claims 28-37

Claim 28 is directed to a transaction system including a customer station produced by the steps of providing an interior building wall with an opening; positioning a frame in the wall opening in supporting connection with the wall; positioning a transaction component in supporting connection with the frame; and mounting a cover in supporting connection with the wall overlying the wall opening, wherein the cover includes a component opening and wherein when the cover is in overlying relation to the wall opening, the transaction component is accessible through the component opening. This is illustrated in Fig. 4 which shows a customer interface area 70 of a cover 68 having carrier opening 72 to access the pneumatic tube carrier delivery and receiving device 24, screen access opening 78 to view a display 80, camera viewing opening 82 to allow a camera to view a customer, and an access opening 85 for accessing an accessory such as the telephone handset 86 (specification, page 15). Claim 28 is interpreted to be a product by process claim since it is directed to a system made by certain steps. It is noted that claim 28 recites that the customer station includes a "component" accessible through a component opening in the cover, but does not define the component. It is also noted that the claim does not recite how the cover is mounted, so cover

Appeal No. 2004-1711
Application 08/889,033

could be permanently affixed; compare "movably mounted" in claim 43.

Appellants argue that: (1) McClure does not disclose a customer station on an interior building wall (Br68-69); (2) McClure does not disclose a customer station having a cover with a component opening (Br69); (3) McClure desires the customer to remain outside of the building (Br69-70); (4) it would not have been obvious to insert the customer station of McClure into Casale/Bustos (Br70); and (5) the combined teachings of McClure and Casale/Bustos would still not produce the claimed invention with a cover on an interior wall (Br70-71).

The examiner asserts that all the limitations are taught by the combination of Casale and Bustos except for the cover which is alleged to be taught by the cover 36 in McClure (EA6; EA22).

We do not agree with the examiner's finding (EA7; EA22) that the claimed "cover" corresponds to the door 36 in Figs. 1 and 3 of McClure because the door does not have a component opening. Appellants' arguments that "McClure does not disclose a customer station having a cover with a[] [component] opening" (Br69) and "[n]or does McClure disclose that a transaction component is accessible when the cover is in overlying relation of a wall opening" (Br69) are based on the examiner's erroneous reading of the claimed cover on door 36. We find that there is a cover over the front of the customer station in Figs. 1-3 of McClure,

Appeal No. 2004-1711
Application 08/889,033

although it is not identified by an element number. The cover "component opening" can be the opening covered by the door 36 for access to the carrier delivery and receiving device because claim 38 is open-ended and does not preclude the opening from having a separate cover. The opening for the speaker/microphone 31 is also a component opening because the speaker/microphone is "accessible" in the sense that a user can listen and speak to it. The cover must be attached to some kind of frame to support the various components as shown in Figs. 2 and 3. Claim 28 does not recite that the cover is movably mounted in supporting connection to the wall; compare claim 43.

However, McClure does not disclose that the frame is installed in an opening in the wall. It is not disclosed how the frame is installed. It would seem that the examiner could have easily found a teaching of installing a component in an opening in a wall, such as an ATM machine, but this has not been done. Moreover, McClure does not disclose that the customer station is installed in an interior wall. While we consider this an easily addressable limitation, we will not enter a new ground of rejection. Casale does not disclose a component of a customer station in a wall, much less an interior wall. While Bustos discloses a component in a wall, see Fig. 5C (not cited or relied upon by the examiner), the wall is not disclosed to be an interior wall; and while Bustos discloses a component in the

interior of a building, see Fig. 5D, the pneumatic carrier delivery device is not installed in a wall, but comes out at the top of the cabinet in the room. The rejection does not tie up all these loose ends and we decline to enter a new ground of rejection by adding further reasoning. We conclude that the examiner has failed to establish a prima facie case of obviousness. The rejection of claims 28-37 is reversed.

Claims 43 and 44

Claim 43 recites a system having a customer station including at least one component, the component being in supporting connection to the wall of a building, and:

wherein the customer station further comprises a cover, and wherein the cover is movably mounted in supporting connection with the wall, and wherein in a first position the cover generally overlies the at least one component, and wherein the cover includes at least one opening, wherein the at least one component includes a first component and wherein in the first position of the cover the first component is manually accessible through the at least one opening, whereby the first component is enabled to be operated by a customer in the first position of the cover, and wherein in a second position the cover is disposed from the at least one component and the at least one component is rendered accessible for servicing.

It is noted that the "carrier delivery and receiving device" is claimed as one of the components and is not required in addition to one of the four components of a visual display, a camera, an audio transmitting device, and an audio receiving device as in claim 1. It is noted that the wall does not have to be an "interior wall" as in claim 38. It is noted that the component

Appeal No. 2004-1711
Application 08/889,033

must be "manually accessible" through the cover, as opposed to claim 28 which only says that the component is "accessible."

Appellants argue that McClure does not disclose a system having a customer station component enabled to be operated by a customer through an opening in a cover movably mounted in supporting connection with a building wall, nor does McClure disclose that the component is accessible for servicing when the cover is moved to a second position (Br72). It is argued that the alleged cover 36 of McClure lacks an opening and does not permit operation of a component in the manner recited (Br73). It is further argued that McClure does not disclose a cover movable to a first position and a second position (Br73). It is argued that Casale, Bustos, and McClure alone or in combination fail to disclose or suggest the claimed features and relationships and there is no motivation for combining features (Br73-74).

The examiner asserts that all the limitations are taught by the combination of Casale and Bustos except for the cover which is alleged to be taught by the cover 36 in McClure (EA6; EA22).

Appellants' arguments that McClure does not disclose a system having a customer station component enabled to be operated by a customer through an opening in a cover is based on the examiner's erroneous reading of the claimed cover on door 36. As noted in the discussion of claim 28, we find that there is a cover over the front of the customer station in Figs. 1-3 of

Appeal No. 2004-1711
Application 08/889,033

McClure, although it is not identified by an element number, and the carrier delivery and receiving device is manually accessible by a user through the opening (the claim does not preclude having a door over the opening). However, even if we were to go beyond the examiner's rejection, McClure does not disclose that the "cover is movably mounted in supporting connection with the wall" and has a first position where the component is manually accessible by a customer and a second position where the component is rendered accessible for servicing. For these reasons, the examiner has failed to establish a prima facie case of obviousness. The rejection of claims 43 and 44 is reversed.

Claims 45 and 46

Claim 45 recites a customer station including at least one component, with the component in supporting connection with an interior wall of a building, "wherein the customer station is produced by a method comprising the steps of: producing an opening in the wall, positioning a frame in the opening in supporting connection with the wall, and positioning the at least one component in supporting connection with the frame." Claim 45 is an odd claim in that it is a system claim having method of making steps. We interpret claim 45 as a product by process claim which results in the same structure as claim 41. We interpret the limitation of "producing an opening in the wall" to

Appeal No. 2004-1711
Application 08/889,033

include both building a wall with an opening and building a wall without an opening and then creating an opening.

Since claim 45 is of essentially the same scope as claim 41 except in product by process form, it is not clear why the examiner has applied McClure. The examiner has generally applied McClure to teach a cover, but no cover is recited in claim 45.

Appellants arguments regarding Casale and Bustos (Br74-78) basically repeat the arguments with respect to claim 41. Appellants argue that: (1) the customer station in McClure is located outside of a building; (2) McClure desires the customers to remain outside of the building in their automobiles for convenience to the customer and safety for the teller; (3) there is no indication of a customer station frame positioned in supporting connection with a frame positioned in an opening of an interior wall of a building; (4) it would not have been obvious for the alleged frame of the banking customer station to be positioned in supporting connection with an interior wall in the interior area of Casale; and (5) McClure cannot overcome the deficiencies in Casale/Bustos (Br78-79).

For the reasons stated in connection with claim 41, which is of commensurate scope, the rejection of claims 45 and 46 is reversed.

Appeal No. 2004-1711
Application 08/889,033

Casale, Bustos, McClure, and Kaehler

Claim 17

The examiner adds Kaehler for the rejection of dependent claim 17, which depends on claim 16. Kaehler does not cure the deficiencies with respect to the rejection of claim 38. Thus, the rejection of claim 17 is reversed.

Remand to consider relevant prior art

The Board reviews the rejections before us, not rejections that could have been formulated from the same references. We are generally reluctant to suggest that the best art has not been applied to the claims on appeal since appellants have spent years responding to examiners' rejections. Nevertheless, in this case, we feel that a remand is necessary because McClure has clearly not been used to its best advantage and because we feel McClure must be considered before the case can be allowed.

McClure was cited to the Office in appellants' initial Information Disclosure Statement (Paper No. 2, filed October 23, 1998). It is clear from the similarities of Fig. 5 of McClure to Fig. 8 of the present invention that appellants were well aware of McClure when the application was filed; while Fig. 1 of McClure is modernized in appellants' Fig. 4, the basic components are all present in a walk-up customer station. McClure also discloses many of the stated advantages of appellants' invention, including providing security for the teller and the fact that

tellers can provide other banking duties during non-service periods of a customer at a customer station. It is not known why the examiner did not apply McClure as a primary reference since it is much better than Casale and Bustos. For example, McClure anticipates claim 1 except for the limitation of "the SP station and the customer station are positioned inside of the building," a limitation that could be easily addressed as pointed out in our analysis. In our opinion, limitations that a customer station is located interior to a building do not form a patentable difference. McClure is a much better reference as to the other claims as well. We remand for the examiner to consider McClure.

As to the cover limitations, although we have noted that McClure discloses a cover which meets some cover limitations, we recommend that, on remand, the examiner consider a reference such as Ramachandran et al. (Ramachandran), U.S. Patent 5,483,047, issued January 9, 1996 (copy attached). Ramachandran shows an ATM having a fascia 18 (corresponding to a cover) which is pivotable between a first position where components are accessible through openings in the fascia and a second position where the components are accessible for servicing; see Figs. 2, 4, and 6. Ramachandran also discloses that it was known to mount ATM units inside the wall of a bank with the customer interface extending through the wall of the bank or freestanding in the lobby of a bank or other commercial establishment (col. 1,

Appeal No. 2004-1711
Application 08/889,033

lines 24-37). Many of the cover limitations are taught or suggested by Ramachandran.

As further guidance, we advise the examiner that the statements that "the various mechanical details listed in claims 5-11, 14-16, 20-23, 28, and 43-46, such as a cover, a door frame, at least one hinge, at least one storage, a sub-frame ... are notoriously well known in the art as a design choice" (EA7) and "[t]he specific mechanical shapes claimed are believed to be merely aesthetic design choice and are in any case not critical to the invention" (EA7) are not considered to be proper obviousness reasons. The examiner should address the obviousness of the structural limitations, preferably with a reference, rather than relying on design choice and non-criticality.


Appeal No. 2004-1711
Application 08/889,033

CONCLUSION

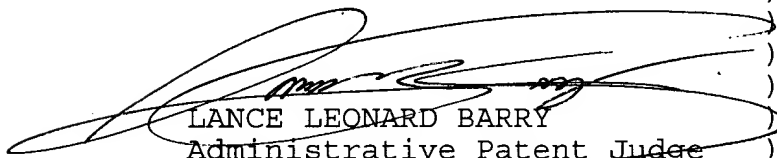
The rejections of claims 1-47 are reversed.

The application is remanded for consideration of prior art.

REVERSED AND REMANDED



LEE E. BARRETT
Administrative Patent Judge



LANCE LEONARD BARRY
Administrative Patent Judge



HOWARD B. BLANKENSHIP
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 2004-1711
Application 08/889,033

RALPH E. JOCKE
WALKER & JOCKE LPA
231 SOUTH BROADWAY
MEDINA, OH 44256